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Christoph Becke

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INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

HANSEN, JAMES ORVILLE

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/816,374
Filing Date: April 01, 2004
Appellant(s): BECKE ET AL.

Russell W. Warnock
For Appellant

EXAMINER'S ANSWER

This is in response to the amended appeal brief filed May 29, 2008, which was in response to the notification of non-compliant appeal brief mailed April 29, 2008 with regards to the appeal brief filed April 18, 2008 appealing from the Office action mailed November 21, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments after Final

The appellant's statement of the status of amendments after final rejection contained in the brief is essentially correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

DE 9014463	Bosch-Siemens	02-1991
JP 13074359	Yamawaki et al.	03-2001
JP 1219483	Sasaki	09-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-11, 14, 17, 19 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over German publication 9014463 [DE`463] in view of Japanese publication 13074359 {2001-74359} [JP`359]. DE`463 (figures 1-4) teaches of a storage compartment (fig. 2) for a refrigerator door, the storage compartment comprising: a box shaped body (20) having a first longitudinal wall (24) and a second longitudinal wall (28) and a given depth (viewed as left to right in fig. 3) extending horizontally between the first and second walls, with a slot (25) extending vertically within the first longitudinal wall at least along a portion thereof; and a compartment divider (30) having a rider (viewed as portion 27 of 22) extending downwardly spaced from a wall thereof located adjacent to the slot for being received within the slot for holding the compartment divider attached within the box shaped body, the compartment divider defining a chamber (fig. 3) for holding small items and extending less than half of

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the given depth (fig. 3), wherein the compartment divider is defined by four connected walls (fig. 2) which do not extend to a bottom of the box shaped body (fig. 3) to define the chamber within the connected walls for holding items therein. DE`463 teaches appellant's inventive claimed structure as disclosed above, but does not show the chamber of the divider as having an open bottom [claim 9] or show the divider as extending substantially entirely over the given body depth [claim 10] or show the divider as having a depth greater than it's width {second distance being less than the first distance} [claim 11]. JP`359 (figures 1-7) is cited as an evidence reference, in the refrigerator door art, to show that it was known to utilize a divider structure (1) within a box shaped body (2) that defines a storage compartment for a refrigerator door (fig. 2) wherein the divider includes an open bottom (note fig. 4 – 1c) for allowing items held therein to rest on a bottom of the box shaped bottom. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the divider of DE`463 so as to utilize an open bottom as unequivocally taught by JP`359 because this arrangement would enhance the retaining capacity of DE`463's divider when long items are desired to be held within the chamber since the open bottom would afford additional storage capacity with enhanced holding capabilities of the long items [since the item is now seated within the divider as opposed to being seated upon the divider] in order to safely retain the items as clearly demonstrated by JP`359 [due to pivoting motion exhibited on the items when the refrigerator door is swung open and shut] and for easy removal of the items – note paragraphs [0017] & [0018] of translated document, wherein one of ordinary skill in the

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art could have substituted one known element (divider with bottom wall) for another (divider with no bottom wall) since the results of the substitution would have been predictable. As to the specific dimensions [size] of the divider, note the following: the position is taken that it would have been an obvious matter of personal preference to vary the size / shape of the divider and to vary the distance of the divider's outer periphery relative to the body's inner periphery depending upon the needs and/or preferences of the user, since such a modification would have involved a mere change in the size of the divider component. A change in size is generally recognized as being within the level of ordinary skill in the art. Furthermore, the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). As such, limitations relating to the size of an element are not sufficient to patentably distinguish over the prior art. As to claim 14, the divider has a height which is less than the height of the body. As to claim 17, the slot and rider form a "friction lock" (viewed as a frictional fit) between the rider and walls of the box shaped body defining the slot as readily apparent to the examiner, in as much as no structural elements are defined. As to claims 19-20, the position is taken that all the claimed limitations have been addressed above with the exception of the following: the divider includes a first sidewall (left wall – fig. 3) separated by a first distance from a second

sidewall (right wall – fig. 3) and third (left wall – fig. 2) and fourth (right wall – fig. 2) sidewalls between the first and second sidewalls that define a second distance, wherein the rider is connected to the first sidewall and extends downwardly and received in the slot of the body.

Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over German publication 9014463 [DE`463] in view of Japanese publication 13074359 {2001-74359} [JP`359] and further in view of Japanese publication 1219483 [JP`483]. The combined prior art teaches appellant's inventive claimed storage compartment as claimed by appellant, but does not show third and fourth sidewalls [left and right walls of the divider] of the divider as having a concave shape in the depth direction. JP`483 (figure 6) is cited as an evidence reference, in the refrigerator door art, to show that it was known to utilize a divider (8) within a box shaped body (7) that defines a storage compartment for a refrigerator (1), wherein the divider includes a concave shape [inwardly directed] on opposite sides for the purpose of separating tall items stored on the body [preferably cylindrical items as is conventionally employed in the refrigerator door storage art]. As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the divider of DE`463 so as to incorporate a concave shape on opposite sidewalls in view of JP`483's teaching because this arrangement would provide more stability to items [presumably cylindrical ones i.e., cans or bottles] located on the box shaped body and next to the divider since the divider could have a sidewall shape that is complementary to the external shape of an item thereby enhancing the storage capacity of the body while improving the body's

capacity to securely retain items while the door is swung between open and closed positions due to the complementary surfaces.

(10) Response to Argument

With regards to appellant's remarks concerning the modification of DE`463 in view of JP`359, note the following: Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, appellant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. Since appellant has submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art

ready for improvement. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Appellant argues that DE`463 provides an enclosed bin that retains smaller items in a confined receptacle and that there is no apparent reason for such a modification as put forth by the examiner. DE`463 [translated document] only cites that the container can be partitioned into compartments (30) having an open upper side, the reference itself does not explicitly reveal a use for the compartments and therefore does not prohibit a potential use. As such, the position is maintained that a *prima facie* case of obviousness has been established since 1) the Office has demonstrated a finding that the prior art contained a device which differed from the claimed device by the substitution of some element with another element; 2) the Office has demonstrated a finding that the substituted element and its function were known in the art; and 3) the Office has demonstrated a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable.

With regards to appellant's remarks that JP`483 does not disclose a device with a concave shape, with respect to the DE`463 and JP`359 combination, but rather a divider having a curved shape; note the following: the examiner has not gone on record and stipulated that the "guardrail" (8) includes a concave shape that bulges inwardly toward a chamber, neither has the examiner attempted to modify the exterior profile of JP`359's compartment divider. The base reference [DE`463] was previously modified to incorporate the known use of an opening along the bottom of a compartment divider, while JP`483 is merely employed to incorporate peripheral concaved surfaces within the divider structure for the purpose of retaining items located outside and adjacent to the compartment divider having a complementary exterior surface (convex - as in the case of a bottle, can or jar for example). DE`463 does show a similar configuration with a divider having concaved surfaces {right side divider in fig. 2} for dividing the compartment into manageable areas for complimentary shaped articles. JP`483 was cited for a clear showing that it was known in the divider art to utilize a device having concave surfaces for the purpose of securing complementary shaped articles within a box-shaped body. The modification of a divider having a chamber with a rectangular exterior profile, in order to incorporate a different exterior profile, in view of a divider having concave side surfaces is deemed reasonable to one having ordinary skill in the art, in view of the evidence submitted.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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